

REMARKS

I. Status of Claims

Further to this Amendment, claims 1-14, 21, 22, 24-26, and 29-91 are pending in this application. Without prejudice or disclaimer, claims 15-20, 23, 27, and 28 are cancelled herein. Claim 91 remains withdrawn from consideration by the Examiner as being directed to a non-elected Group. Applicant respectfully reminds the Examiner of the obligation to rejoin the non-elected Groups should the elected claims be found allowable, and of the duty to extend the search to a reasonable number of non-elected species should the elected species be found allowable.

Claims 1, 24, 29, 31 and 54 are amended herein. Claim 1 was amended to incorporate the subject matter of cancelled claims 18, 20, 23, and 28; claims 24, 29, 31 and 54 were amended to correct their dependency; and claim 29 was further amended to clarify the subject matter. Support for these amendments can be found in the claims as originally filed. Accordingly, now issue of new matter was raised by these amendments.

II. Rejections Under 35 U.S.C. § 112

A. *First Paragraph*

The Examiner rejected claims 1-90 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Office Action at pages 4-6. The Examiner states, “the specification . . . does not reasonably provide enablement for the monomeric residues without limitation (i.e., no named compounds), see claim 1.” *Id.* at page 4. The Examiner also states that “it would require undue experimentation to one of ordinary skill in the art to resolve any monomeric residues without limitation,” and

requests that Applicant limit the “named compounds (i.e., claim 31) into claim 1.” *Id.* at page 6. Applicant respectfully disagrees and traverses the rejection for the following reasons.

The “overall test of enablement” is whether one reasonably skilled in the art could make or use the invention from the disclosure, when filed, in the patent application coupled with the information known in the art without undue experimentation. See M.P.E.P. 2164.01. As acknowledged by the Examiner, the factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure satisfies the enablement include, but are not limited to:

- (A) The breadth of the claims;
- (B) The nature of the invention;
- (C) The state of the prior art;
- (D) The level of one of ordinary skill;
- (E) The level of predictability in the art;
- (F) The amount of direction provided by the inventor;
- (G) The existence of working examples; and
- (H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). Applicant respectfully submits that consideration of these factors would lead to the conclusion that one of ordinary skill in the art could practice the claimed invention without undue experimentation.

The nature of the invention is directed to cosmetic or dermatological compositions comprising at least one gradient copolymer comprising at least two

different monomeric residues, wherein at least one monomeric residue is a hydrophilic monomeric residue, which is present in an amount ranging from 2% to 70% by weight, relative to the total weight of the copolymer, wherein at least one monomeric residue results from at least one monomer which is capable of forming a homopolymer with a T_g less than or equal to 20°C, and which is present in an amount ranging from 10% to 90% by weight, relative to the total weight of the copolymer, and wherein the gradient copolymer exhibits a mass polydispersity index (I_p) less than or equal to 2.5. See independent claim 1.

The Examiner states that the monomeric residues of claim 1 are “without limitation.” *Id.* Applicant respectfully disagrees, and points out that the claims are currently under examination for the elected monomeric species, ethyl acrylate and styrene, as indicated in the Response to Restriction Requirement submitted March 20, 2008 and confirmed by the Examiner at page 2 of the Office Action. In addition, the mass polydispersity index recited in claim 1 further limits the monomeric residues that can be used. Finally, in an effort to advance prosecution, claim 1 was amended to further define the at least two different monomeric residues recited in this independent claim. Therefore, Applicant respectfully submits that the monomeric residues recited in claim 1 are not “without limitation.”

The Examiner next mentions the state of the art, and indicates that the prior art teaches a “similar cosmetic composition comprising styrene and isoprene.” Office action at page 5. Thus, the Examiner implicitly acknowledges that monomeric residues are generally known by the skilled artisan to form copolymers. To this knowledge, the disclosure of the present specification set forth the starting materials, i.e., the at least

two monomeric residues which can be used to form the at least one gradient copolymer recited in the claimed invention. To this end, Applicant respectfully directs the Examiner's attention to the present disclosure which contains:

- 1) A detailed description of the process for preparing the at least one gradient copolymer (Specification at paragraphs [026] through [031]);
- 2) Example of an embodiment of a gradient copolymer according to the disclosure (Specification at paragraphs [053] through [058]);
- 3) Examples of monomeric residues that can be incorporated into the at least one gradient copolymer (Specification at paragraphs [060] through [092]); and
- 4) Synthetic Examples 1-9 directed to the synthesis of numerous gradient copolymers according to the present disclosure (Specification at paragraphs [0152] through [0193]).

The present disclosure therefore provides a large amount of guidance regarding how to make the at least one gradient copolymer and what monomeric residues form the at least one gradient copolymer. Moreover, Applicant states in the specification that “[a] person of ordinary skill on the art should be able to select the monomers and their amounts in relation to the desired result, on the basis of his or her general knowledge, and, for instance, the relative reactivity of each monomer.” *Id.* at paragraph [092].

In addition, claim 1 was amended to further define the at least two different monomeric residues recited in the claim. Thus, Applicant submits that the amount of experimentation necessary would not be undue to one of ordinary skill in the art given the amount of guidance set forth in the specification and claims.

Moreover, the Federal Circuit has emphasized that “the specification [need not] necessarily describe how to make and use every possible variant of the claimed

invention, for the artisan's knowledge of the prior art and routine experimentation can often fill gaps, interpolate between embodiments, and perhaps even extrapolate beyond the disclosed embodiments, depending upon the predictability of the art." *AK Steel Corp. v. Sollac*, 344 F.3d 1234, 1244 (Fed. Cir. 2003) (citations omitted). In the present case, Applicant respectfully submits that the disclosure, examples in the specification, and claims more than suffice a finding of enablement.

Further, "[a]s concerns the breadth of a claim relevant to enablement, the only relevant concern should be whether the scope of enablement provided to one skilled in the art by the disclosure is commensurate with the scope of protection sought by the claims." M.P.E.P. § 2164.08. Here, in determining the breadth of a relevant claim to the enablement of the disclosure, the Examiner fails to set forth how the disclosure does not enable one skilled in the art to make and use the entire scope of the claimed invention without undue experimentation, yet asserts that "[t]he instant breadth of the rejected claims is broader than the disclosure, specifically, the instant claims include any monomeric residues without limitation." *Id.* at page 6.

Applicants respectfully assert that the monomeric residues as recited, for example, in claim 1, are a genus group representative of various specie compounds disclosed in the specification, the representation of which is widely used in patents disclosing similar genus-specie compound relationships. And the at least two different monomeric residues recited in the in the foregoing amendment claim 1 further define these monomeric residues. The mere fact that the monomeric residues that form the at least one gradient copolymer may represent multiple chemical species does not support lack of enablement of the claims. As stated above, the specification and claims enable

one skilled in the art to practice the disclosed embodiments, including several examples of the monomeric residues that can be used to form the at least one gradient copolymer.

In view of these arguments and the amendment to claim 1, Applicant respectfully submits that the enablement rejection is in error, and should be withdrawn.

B. Second Paragraph

The Examiner further rejects claims 1-90 under 35 U.S.C. § 112, second paragraph, as allegedly indefinite. Office Action at pages 6-7. The Examiner contends that “[s]uch breadth in view of the limited exemplification and the lack of scope of subject matter resulted from a search of the prior art indicated that the ‘scope’ of claims 1-90 can not [sic] be ascertained.” *Id.* Applicant respectfully disagrees and traverses the rejection in view of the following reasons.

Applicant respectfully points out that, as required in the Response to Restriction Requirement of March 20, 2008, Applicant elected two monomeric residues: ethyl acrylate and styrene. Thus, it is unclear at this point why the two elected species engenders the conclusion that there is a “lack of scope of subject matter” and the scope of the present claims cannot “be ascertained.” For at least this reason, the rejection is improper and should be withdrawn.

Notwithstanding the lack of support for a proper § 112, second paragraph rejection, Applicant also asserts that it is improper to equate breadth of a claim to indefiniteness. M.P.E.P. § 2173.04. “If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims

comply with 35 U.S.C. 112, second paragraph.” *Id.* Here, the scope of the claims can be determined: if at least two different monomeric residues are present in a gradient copolymer that has a mass polydispersity index within the claimed range, then those monomeric units fall within the scope of claim 1; and if the at least two different monomeric residues fall within the definitions and amounts recited in claim 1.

Accordingly, the rejection is improper and Applicant respectfully requests its withdrawal.

III. Rejection Under 35 U.S.C. § 102(b)

The Examiner rejected claims 1-90 under 35 U.S.C. § 102(b) as being “anticipated” over U.S. Patent No. 6,113,930 to Mondet et al. (“Mondet”). Office Action at page 7. Specifically, the Examiner alleges that Mondet discloses “a cosmetic composition comprising at least one naturalized [*sic*] ioni-forming [*sic*] polymer (i.e., styrene) and an additional aqueous polymer dispersion [*sic*] (i.e., ethyl acrylate, 2-hydroxypropyl acrylate)” *Id.* Therefore, the Examiner concludes that the cosmetic compositions of Mondet “anticipate the instant invention.” *Id.* Applicant respectfully disagrees and traverses the rejection in view of the following reason.

The legal standard for anticipation under § 102(b) is that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987); *see also Minnesota Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559 (Fed. Cir. 1992). In the present case, the Examiner has failed to establish that each and every element recited in, for

example, independent claim 1 is disclosed by Mondet. As set forth in the Application, independent claim 1 is directed to:

[a] cosmetic or dermatological composition comprising at least one gradient copolymer comprising at least two different monomeric residues,

wherein at least one monomeric residue is a hydrophilic monomeric residue, which is present in an amount ranging from 2% to 70% by weight, relative to the total weight of the copolymer, and

wherein at least one monomeric residue results from at least one monomer which is capable of forming a homopolymer with a Tg less than or equal to 20°C, and which is present in an amount ranging from 10% to 90% by weight, relative to the total weight of the copolymer,

wherein the at least one gradient copolymer exhibits a mass polydispersity index (Ip) less than or equal to 2.5.

See claim 1.

In contrast, Mondet is directed to cosmetic compositions “comprising at least one neutralized ionic film-forming polymer, water and at least one polar organic solvent” See Abstract. Mondet is wholly silent to any teaching of gradient copolymers and moreover, lacks any teaching of its film-forming polymers discloses therein defined by a mass polydispersity index, a required component of the instant claim 1. Thus, Applicant asserts that Mondet fails to teach all the claim limitations of at least independent claim 1 and the Examiner’s assertion to the contrary are unsupported. Accordingly, the rejection is issued in error and Applicant respectfully requests its withdrawal.

IV. Rejection Under 35 U.S.C. § 103(a)

The Examiner rejected claims 1-90 under 35 U.S.C. § 103(a) as being allegedly obvious over Mondet. Office Action at pages 8-10. Specifically, the Examiner asserts that “Mondet et al. cosmetic compositions overlap with the instant invention” and “[o]ne having ordinary skill in the art . . . would be motivated to employ the product of Mondet et al. to obtain instant claimed composition comprising at least two different monomeric residues” because “[t]he motivation to make the claimed compounds derived from the known compositions of Mondet et al. would possess similar activity (i.e., cosmetic compositions) to that which is claimed in the reference.” *Id.* at pages 9-10. Applicant respectfully disagrees and traverses the rejection for at least the following reasons.

“The proper analysis is whether the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all of the facts.” M.P.E.P. §2141 (III). Applicant takes the position that after consideration of all the facts herein, Mondet does not render the present claims obvious.

As an initial matter, several basic factual inquiries must be made in order to determine the obviousness or non-obviousness of claims of a patent application under 35 U.S.C. § 103. These factual inquiries, set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 U.S.P.Q. 459, 467 (1966), require the Examiner to:

- (1) Determine the scope and content of the prior art;
- (2) Ascertain the differences between the prior art and the claims in issue;
- (3) Resolve the level of ordinary skill in the pertinent art; and
- (4) Evaluate evidence of secondary considerations.

The obviousness or non-obviousness of the claimed invention is then evaluated in view

of the results of these inquiries. *Graham*, 383 U.S. at 17-18, 148 U.S.P.Q. at 467; see also *KSR Int'l Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385 (U.S. 2007).

It is important to note, moreover, that the prior art references relied upon in a rejection “must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention,” when such reasons are articulated by the Examiner. M.P.E.P. § 2141.02(VI). Further, “[a]scertaining the differences between the prior art and the claims at issue requires interpreting the claim language, and considering both the invention and the prior art references as a whole.” M.P.E.P. §2141.02.

Applicant submits that Mondet, when considered as a whole, in no way renders the present claims obvious. Mondet is directed solely to film-forming copolymers. However, independent claim 1 requires a gradient copolymer comprising at least two different monomeric residues as recited in independent claim 1. Moreover, the gradient copolymer exhibits a polydispersity index, i.e., a particular ratio of the weight-average molecular weight (Mw) to the number-average molecular weight (Mn), as recited in independent claim 1. Mondet fails to disclose any gradient copolymer. Thus, for at least these reasons, Mondet, when viewed as a whole, lacks any teaching or suggestion that would not lead one of ordinary skill in the art to the claimed at least one gradient copolymer. Accordingly, Applicant respectfully assert that the rejection is issued in error and respectfully request its withdrawal.

V. Double Patenting

The Examiner rejected claims 1-90 for obviousness-type double patenting over claim 36 of Mondet. Office Action at pages 10-12. Applicant respectfully disagrees and traverses the rejection for at least the following reasons.

In making an obviousness-type double patenting determination, the analysis parallels the guidelines for a 35 U.S.C. § 103(a) rejection, including the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), as set forth above. M.P.E.P. § 804.

Here, as Applicant asserted above, there is no teaching or suggestion in Mondet that would motivate one of skill in the art to obtain the presently claimed composition. Specifically, claim 36 of Mondet is directed to film-forming polymers only with no recitation of at least one gradient copolymers, as recited in independent claim 1. The Examiner has not set forth any evidence, beyond mere conclusory statements, to support the allegation that one of skill in the art would be motivated to look to Mondet in order to arrive at the present invention. For at least these reasons, Applicant respectfully requests withdrawal of this rejection.

VI. Conclusions

In view of the foregoing amendments and remarks, Applicant respectfully requests the reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: December 30, 2008

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